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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,290	12/11/2000	George Bradley Hobbs	10003973-1	3711

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Intellectual Property Administration
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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/734,290	Applicant(s) HOBBS, GEORGE BRADLEY	
	Examiner Jean Janvier	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/05/06 has been entered and a Non-Final Office Action is presented below.

Response To Applicant's Arguments

Applicant's arguments with respect to claimed invention have been considered but are moot in view of the new ground(s) of rejection. In other words, Applicant's arguments are based on the newly amended claims and are fully addressed in the present Action.

Detailed Action

Specification

Status of the claims

Claims 1-26 and 29-34 have been elected, without traverse, for prosecution on the merits and claims 38-40 are withdrawn from further consideration. Applicant is herein required to cancel claims 38-40 in a future correspondence since the restriction has been made final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 and 29-34 are rejected under 35 USC 103(a) as being unpatentable over Dutta, USP 6, 891, 635B2.

As per claims **1-26 and 29-34**, Dutta discloses a method of and a system for providing advertisements in web based printing over a communication network (communication link), such as the Internet. A remote printing web server receives advertisements from one or more advertisers (registering a plurality of advertisements from a plurality of advertisers). The advertisements may include target audience attributes, such as the profession of target audience members (advertisers' criteria). Digital advertising images and the target audience information are stored on the remote printing web server (storing the received advertisements in a database coupled to the print processing system). A print user (customer) connects to the remote printing web server, over the network, using a browser. Information about the user (user's profile), such as the user's occupation, is gathered in order to match the user with appropriate advertisements such that targeted advertisements can be presented or displayed to the user, over the network.

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when the print processing system or the web server processes a print job or print a request for printing submitted by the user. Advertisements are identified and combined with the document that the user wishes to print (presenting or displaying a customized advertisement in the user's document printed by the print processing system). The combined document is then printed on a printer connected to the remote printing web server. In addition, the document that the user wishes to print may be analyzed for document content in order to further select appropriate advertisements to include on the user's printouts or print jobs (presenting or displaying a customized advertisement in the user's document printed by the print processing system or printing web server based on the user's document content) or print job request).

(See abstract; col. 2: 5-32).

The present system deals with providing advertisements in web-based printing. More particularly, the present system deals with providing free or subsidized printing in exchange for advertising space on printed documents (col. 1: 9-14; col. 1: 15 to col. 2: 3).

Dutta discloses, in general, a system where advertisements can be placed on printouts requested by users of remote printers. Advertisers sign up to advertise to the general public or to particular groups of users. When a user is traveling and needs to print a document on a remote printer (i.e., a hotel, airport, copy service printer, etc.), he is asked for information about his occupation and other personal attributes of the user. This information is used to select advertising that is appropriate to the user. The user requests to print out electronic documents and the selected advertisements are included in the printout (col. 2: 5-39).

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FIG. 1 is a network diagram showing the components used in remote web based printing with advertisements. Computer network 100, such as the Internet, is used to connect the various components to one another. Client device 110 such as a portable computer or other pervasive computing device is used as a user print client to connect to computer network 100. A program, such as browser 115 (i.e., Netscape Navigator.TM. Microsoft Explorer.TM., etc.) is used to communicate with other devices connected to computer network 100. **The user of client device 110 may wish to print a document stored on the client device, such as a word processing document or spreadsheet, or may wish to print a document stored on a third party server connected to computer network 110. When the user of client device 110 (customer's interface) wishes to print to remote printer 190, he or she interacts with software located on remote printing web server to send print request (print job) 120 through computer network 100 to remote printing web server 170 (print processing system). Remote printing web server 170 receives print request 150, inserts one or more advertisements into the printout and prints the electronic document and the included advertisements onto printer 190 (It is herein understood that the printing web server implicitly supports the step of creating or assigning a job number or ticket number to each print job or print request submitted by a user-col. 3: 3-23; col. 3: 23-59).**

Advertisement insertion system 220 of fig. 2 includes four component functions. Advertisement repository puts and removes advertisements in a data storage area accessible by the remote printing web server. The repository also includes information about the intended audience for each advertisement stored in the repository. **Document content type determiner 230 is software for determining the type of document being printed based on keywords**

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found in the document or other attributes of the document (i.e., website from which the document was downloaded, document titles, etc.). Document content type determiner also includes the type of file being printed, such as a spreadsheet, a word processing document, or a web page. User type determiner software 235 determines the type of user that is printing a document (i.e., a doctor, an engineer, an accountant, etc.). This information can be gathered using interactive software that requests the information from the print user before a document is accepted for printing. Advertisement mapping table 240 is an electronic table including advertisement names (i.e., file names or other advertisement identifier) and the types of documents and users that are the target audience for the advertisement (presenting or displaying or inserting one or more targeted advertisements into the user's printed document when the printing web server processes the use's print request based on the user's profile (identification) and the type of document or file format being printed, quality of paper, printing of envelopes including other printing options). The advertising mapping table may also keep track of the number of times each advertisement has been included in a printout. (All ads displayed into the printed documents are registered ads col. 3: 60 to col. 4: 40).

Finally, FIG. 6 is a diagram showing the components involved in providing a printed document including registered advertisements. Advertisement insertion system table 600 (see FIG. 2 wherein the table was previously referred to as advertising matching table 240) includes user types (identified user), content types (document being printed) and advertising impressions suitable for the user type/content type. For example, when the user type (user's identification) is a "lawyer" and the document content type is a "spreadsheet" then advertisement #2 is

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appropriate. When the user type is a "doctor" and the document content type is a "spreadsheet" then advertisements #1 and #3 are appropriate. Finally, when the user type is a "doctor" and the document content type is a "word document" then advertisement #4 and #3 are appropriate. User client type 610 is received from the user's registration information from the user requesting to print. In the example shown, the client type is "doctor." Document type 620 is determined from the document sent for printing; in the example shown the document type is a spreadsheet (file type, file format). Advertisement insertion table 600 is used to determine that, for the example shown, advertisements #1 and #3 should be included with the printout. The advertisement images are retrieved from advertisement repository 630. Selected advertisements 640 are then inserted in the spreadsheet being printed, in this case a pharmacy ad from Advertiser X, and a medical equipment advertisement from Advertiser Z. The modified document (now including the advertising images), is then printed creating printed document 650. Advertisement insertion system table 600 also keeps track of the number of impressions left to be printed. In the example shown, **Ad #1 would be decremented from 224 impressions to 223 impressions and Ad #3 would be decremented from 193 impressions to 192 impressions left to be printed (col. 6: 14-45).**

As per claims 1, 11, 21, 24, 33 and 34, Dutta does not expressly disclose displaying the advertisement on the customer's interface (computer screen or display), while receiving or processing the print job, instead of printing the advertisement together with the customer's document.

However, it is common practice in the art to display an advertisement on a user's computer screen while the user's computer is dialing into an ISP system in order to connect to the Internet or during an idle time period as the user is waiting for a requested information or page to be retrieved or down loaded from a web server related to a web site in return for the privilege to receive free or discounted Internet service from the ISP (Internet Service Provider), which uses the revenues, collected from the advertisers to display their advertising content to the user(s), to subsidize the free or discounted service received by the user(s). Furthermore, it is well known in the art to display advertisements to a user's computer screen while the user is waiting for requested information to be retrieved or downloaded from a server related to an accessed web site. It is also customary in the art to allow a user accessing the Internet via an ISP to first read product information or advertising literature before the user is able to access the web for a limited free period of time, wherein revenues collected by the ISP from advertisers are used to subsidize the limited and free period of time provided to the user in return for reading or view product information displayed on his screen (no further disclosure is necessary here).

“Official Notice”

Thus, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the advertising distribution and printing system of Dutta so as to display a (targeted) advertisement on the screen of a computer's user upon receiving or while processing the user's print job instead of printing the advertisement along with the user's document associated with the print job especially if the printed document is addressed to a third party, such a prospective employer or recruiter, who should not receive or be exposed to the printed advertisement in the first place, thereby avoiding the embarrassment

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resulting from knowingly or accidentally printing an advertisement on top of a page of a document that is addressed to an important third party or VIP, such a prospective employer or a president of a hiring corporation, and efficiently using processing idle time by outputting the advertisement on the user's computer screen, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less papers and thus, cutting fewer trees, by displaying the advertisement on the user's computer screen (customer's interface) as the user is waiting for the print job or the document to be printed or executed especially if the print queue contains other previously submitted print jobs that should be processed before the user's print job.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,882,439B2 to Ishijima discloses a system relating to a printing service method for discounting services by printing with advertisements and realizes various discount services. The present invention comprises: a printing step for sending printing management information along with the user ID to the server 4 through the network 3 when the user prints with advertisements with the user's printing device 2, and storing that information as an advertisement usage record for each user ID; a step for referencing the user's advertisement usage record, for least one service, selected by the user from among a plurality of services relating to the printing device

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that used the advertisement printing record, determining whether to authorize the discount for the selected service, and updating the advertisement usage record of the abovementioned user to perform the authorized discount service. A variety of discount services can be realized because the print operation with advertisements is managed by the server and the user can use the usage records.

USP 6,981,015B1 to Palmer discloses a system and method of managing print services provided by a print provider includes defining a network communication link between the print provider and a print managing system controller having the print services provided by the print provider registered therewith. The print managing system controller collects data related to the print services provided by the print provider and analyzes the data related to the print services provided by the print provider.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

05/11/06

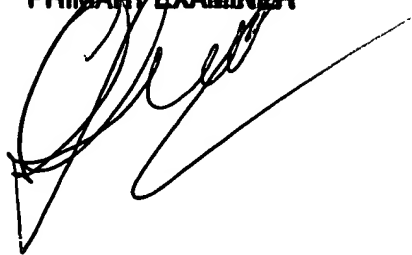
JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to be 'JDJ' with a long, sweeping horizontal stroke extending to the right.